

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-3 and 5 are rejected under 35 USC 102(b) over the U.S. patent to Godrey et al.

Claim 6 is rejected under 35 USC 102(b) as anticipated by the patent to Godrey et al or under 35 USC 103(a) as obvious over the Godrey et al.

The Declaration is objected to and Claim 6 is rejected under 35 USC 112.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants amended the claims to more clearly define the present invention and to distinguish it from the prior art applied by the Examiner against the original claims.

Claim 1 has been amended to define additionally that the coupling means is provided to connect the saw blade to a lifting rod in an installed state of the saw blade. This feature is disclosed in the specification on page 8, lines 5

and 6 and clarifies the functions of the coupling means (10). Applicants also submitted additional dependent Claims 15-23.

The feature of Claim 15 is disclosed in the specification on page 7, lines 23-24 and in Figures 2 and 3 of the drawings.

The feature of Claim 16 can be derived from Figure 3 of the application. The feature of Claim 17 is illustrated in Figures 3 and 4 of the drawings. The feature of Claim 18 is disclosed in Figure 3 of the drawings.

The features of Claims 19 and 20 are disclosed in the specification on page 7, lines 27-28 and illustrated in Figure 3 of the drawings. The feature of Claim 21 is disclosed in the specification on page 9, lines 22-23. The feature of Claim 22 is disclosed on page 9, lines 25-26 of the specification and shown in Figure 4 of the drawings.

Finally, the feature of Claim 23 is disclosed on page 7, lines 3-4 of the specification and illustrated in Figure 2 of the drawings.

Turning now to the prior art applied by the Examiner, and in particular to the U.S. patent to Godrey, it can be seen that this reference discloses a handheld power saw (10), which has a guide assembly with two

lateral bracing means (88, 90). The guide assembly guides an oscillating motion of a lifting rod (78) on which a saw blade B is connected, as explained in column 3, lines 27-28 and shown in Figures 1 and 5 of the drawings in this patent. A blade (94) is provided to connect the saw blade B to the lifting rod (78) in an installed state of the saw blade B, as explained in column 3, lines 27-28 of the reference.

In applicants' opinion, a not rigidly attached pin (80), but rather the blade clamp (94) is a coupling means of the U.S. patent to Godrey, since the blade clamp (94) is provided to connect the saw blade B to a lifting rod (78) in an installed state of the saw blade B.

The U.S. patent to Godrey therefore discloses that the lateral bracing means (88, 90) of the guide assembly are arranged in a longitudinal direction of the saw blade B behind the coupling means (94). Thereby, shear forces acting on the saw blade B first arrive at the coupling means (94) before the bracing means (88, 90), and therefore the bracing means (88, 90) cannot shield the coupling means from the forces acting on the saw blade.

Furthermore, the lateral bracing means (88, 90) of the guide assembly disclosed in the patent to Godrey guide the oscillating motion of the driving rod solely. In contrast, Claim 1 now defines that the bracing means (18,

18') of the guide assembly (14) guide an oscillating motion of the saw blade (12). Thus, the bracing means (88, 90) which are disclosed in the U.S. patent to Godfrey neither guide the saw blade B nor shield the coupling means (94) from shear forces acting on the saw blade B.

The original claims were rejected over this reference as being anticipated. It is believed to be clear that this reference does not disclose the new features of the present invention. In connection with this, it is believed to be advisable to cite the decision In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the power tool disclosed in the patent to Godfrey does not include each and every element of the present invention as defined in Claim 1. Therefore, it is respectfully submitted that the anticipation rejection applied by the Examiner against the original claims should be considered as no longer tenable with respect to amended Claim 1 and should be withdrawn.

As for the obviousness rejection, it is respectfully submitted that since the reference contains no hint, suggestion, or motivation for the new features of the present invention, a person of ordinary skill in the art will

familiarize himself with the teaching of the U.S. patent to Godfrey would not arrive at the present invention. Instead, in order to arrive at the present invention as defined in amended Claim 1, the reference has to be fundamentally modified, and in particular by including into it the new features of the present invention which are now defined in amended Claim 1. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments it is believed that Claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.


As for the dependent claims, these claims define additional features, which, in combination with the features of Claim 1 clearly and patentably distinguish the present invention from the prior art. These claims should be allowed as well.

With the present Amendment applicant has also submitted the new Declaration as required by the Examiner.

Reconsideration and allowance of the present application with all the claims currently on file is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,


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